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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,843	12/14/2001	Gabriele Govoni	ZZ 5317 DIV2 (C15488/1272	9867

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EXAMINER	
TRAN, HIEN THI	
ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/016,843	GOVONI ET AL.	
	Examiner	Art Unit	
	Hien Tran	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 35-39 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 35-39 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 14 December 2001 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 08/684,411.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 4/12/02.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/684,411, filed on 7/19/96. ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "12" (Fig. 1). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the drawings to comply with CFR 1.84(p)(5), e.g. they should include the reference sign(s) mentioned in the specification and vice versa.

Specification

4. The disclosure is objected to because of the following informalities:

On page 1, insertion before the first line --, now US Patent No. 6,413,477-- should be inserted after "1997".

On page 3, line 10 "thorough" should be changed to --through--. See page 26, lines 19-20 likewise.

On page 11, line 20 "zones" should be changed to --zone--.

On page 13, between lines 7 and 8 --BRIEF DESCRIPTION OF THE DRAWINGS-- should be inserted.

On page 24, line 9 --broadening-- is misspelled.

On page 27, the last line --or recycle line for gaseous mixture-- should be inserted before "36" for clarity and consistency (note page 26, lines 6-7).

On page 30, line 10 "component" should be changed to --components--; in line 18 "were" should be changed to --where--.

Appropriate correction is required.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 38-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, in claim 38, line 3 the phrase of "excluding a gas fluidization line" is nowhere disclosed in the instant specification.

In claim 39, line 11 the recitation of "no gas inlet is provided .... an upward flow" " is nowhere disclosed in the instant specification.

It should be noted that the negative limitations/exclusionary provisions must have any antecedent basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393, (Bd. App. 1983). Note that the mere absence of a positive recitation in a claim is not a basis for an exclusion recitation.

Applicants are required to cancel the new matter in the reply to this Office action.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 38-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 38, line 3 it is unclear as to where it is disclosed in the original specification.

In claim 39, line 11 it is unclear as to what applicants are attempting to recite and where i disclosed in the original specification.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 35-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Kono et al (3,848,016).

With respect to claims 35, 37, Kono et al disclose an apparatus comprising: a first reactor chamber 1 having first and second connection points; a second reactor chamber 3 with an outlet line; the second reactor chamber having first and second connection points; the first and second connection points of each chamber being positioned above the second connection point of each chamber; the first connection point of the first chamber being connected with the first connection point of the second chamber; an inlet line 6 for supplying a material to the first chamber 1; an outlet line 12 for discharging a material from the second chamber 3; a separator 2 connected to the second chamber 3 and a recirculation line 10, 17 connecting the separator 2 to the first chamber 1 at a position below and separate from the inlet line 6.

With respect to claim 36, Kono et al discloses that the first connection point of the first chamber 1 is directly connected with the first connection point of the second chamber 3 (see, for

example lines 14, 15 or 14, 16, 17); and the second connection point of the first chamber being connected with the second connection point of the second chamber via lines 9, 11.

With respect to claim 37, Konno et al discloses a recirculation line 10, 17 connecting the separator 2 to the first chamber 1 at a position separate from the inlet line 6.

With respect to claims 38-39, the second chamber in Kono et al does not have a gas fluidization line or an upward gas flow.

Note that intended use is of no patentable moment in apparatus claims.

Instant claims 35-39 structurally read on the apparatus of Kono et al.

12. Claim 37 is rejected under 35 U.S.C. 102(e) as being anticipated by Govoni et al (5,728,353).

Govoni et al discloses an apparatus comprising: a reactor vessel having:

a first reactor chamber 106 having first and second connection points; a second reactor chamber 105 with an outlet line 185; the second reactor chamber having first and second connection points; the first connection point of each chamber being positioned above the second connection point of each chamber; the first connection point of the first chamber being connected with the first connection point of the second chamber; the second connection point of the first chamber being connected with the second connection point of the second chamber; an inlet line 164 for supplying a monomer to the first chamber 106; an outlet line 185 for discharging a polymer from the second chamber 105; a separator 165 connected to the second chamber 105 and a recirculation line 162 connecting the separator 165 to the first chamber at a position separate from the inlet line 164 (note the line passing through valve 173).

Instant claim 37 structurally reads on the apparatus of Govoni et al.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Govoni et al (5,728,353).

With respect to claim 36, Govoni et al discloses that the first connection point of the first chamber is connected with the first connection point of the second chamber via lines 155, 156; and the second connection point of the first chamber is connected with the second connection point of the second chamber via line 166. Although there is a valve 175 located in lines 155, 156, such valve may be eliminated if one is willing to forgo its benefits in the system since the presence of the other valves, 171, 172 in the system is capable of effectively control the flow therein.

Furthermore Fig. 3 of Govoni et al shows the directed connecting between the first and second chambers.

It would have been obvious to one having ordinary skill in the art to directly connect the two chambers as taught by Govoni et al as an alternative, on the basis of its suitability for the intended use as a matter of obvious design choice, absence showing any unexpected result thereof and since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 35-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,413,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same conceptual invention.

Claims 1-11 of US Patent No. 6,413,477 encompass claims 35-37. With respect to claims 38-39, since Claims 1-11 of US Patent No. 6,413,477 has not recited any gas fluidization line in the second reactor and therefore meet instant claims 38-39.

18. Claims 36-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-10 of U.S. Patent No. 5,728,353. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same conceptual invention.

The same comments with respect to Govoni et al '353 apply.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is (571) 272-1454. The examiner can normally be reached on Tuesday-Friday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT

Hien Tran

Hien Tran
Primary Examiner
Art Unit 1764